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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,931	06/28/2001	Masahide Hio	FP01-003US	5384
1218	7590	08/20/2009		
CASELLA & HESPOS 274 MADISON AVENUE NEW YORK, NY 10016				
EXAMINER				
GUSHI, ROSS N				
ART UNIT		PAPER NUMBER		
2833				
MAIL DATE		DELIVERY MODE		
08/20/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/893,931

Applicant(s)

HIO ET AL.

Examiner

ROSS N. GUSHI

Art Unit

2833

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9 and 12-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9 and 12-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 8/10/09 has been entered.

Claim Objections

Claims 9, 12, 13, and 14 are objected to under 37 C.F.R. Rule 1.75(d)(1). The terms and the phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. In particular, the "single plane," the "opposite planar surfaces," the and "first and second edges" lack antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. Correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 9 and 12-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, regarding claim 9, the limitation of that "each of said locks being completely planar to define a single plane aligned normal to the respective side walls and the base wall" which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim Rejections - 35 USC § 102 and 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hotea in view of Chesnais et al. ("Chesnais") and Abe. Regarding claim 9, Hotea discloses an insulation-displacement terminal fitting, comprising: a base wall 12, first and second opposed parallel side walls (15, 16) projecting perpendicularly from opposite sides of the base wall and defining a wire-receiving space between the side

walls, first and second opposed V-shaped insulation-displacement portions projecting respectively from the first and second side walls into the wire-receiving space (at 6, see figure 2 and col. 1, line 60), first and second locks (not labeled, see figure 2, showing the locks rearward of the v-shaped IDC portions) projecting respectively from the first and second side walls into the wire-receiving space in positions spaced from the insulation-displacement portions, said first and second locks having opposite planar surfaces and being formed respectively with first and second edges extending between the opposite planar surfaces of the respective locks, the first and second edges defining portions distal ends of the respective first and second locks furthest from the respective first and second side walls, projecting ends of the insulation-displacement portions being configured for cutting a resin coating on a wire inserted into the wire receiving space so that a core of the wire contacts the projecting ends of the insulation-displacement portions, and the edges of the locks being disposed to bite into the resin coating and engage cut-open surfaces of the resin coating, for resisting a pull out force on the wire in directions along the longitudinal direction of the wire and normal to the planar surfaces of the locks.

Hotea shows the locks as being inclined slightly toward the IDC portions (see figure 2). Abe discloses a connector where the locks 11 are shown unambiguously perpendicular to the side wall with each of the locks 11 being completely planar to define a single plane aligned normal to the side walls (see figure 1a) so that the planar surfaces of each of said locks 11 are aligned normal to a longitudinal direction of the wire. Likewise Chesnais a connector where the locks (7, 8) are shown unambiguously

perpendicular to the side wall with each of the locks (7, 8) being completely planar to define a single plane aligned normal to the side walls (see figure 4) so that the planar surfaces of each of said locks are aligned normal to a longitudinal direction of the wire.

At the time of the invention, it would have been obvious to have the Hotea locks be configured perpendicular to the side walls as taught in Chesnais and Abe. The choice between having the locks inclined slightly (as in Hotea) or perpendicular to the sidewalls (as in Abe and Chesnais) would have been a matter of engineering design choice. The substituted components and their functions were known in the art. One with ordinary skill in the art could have substituted one known element for another and the results of the substitution would have been predictable. *KSR International Co. v. Teleflex Inc.*, 82 USPQ.2d 1385 (2007).

Per claim 12, locks project by a sufficient distance for contacting the core (as taught in Abe and Chesnais).

Per claim 13 the locks and the insulation-displacement portions project substantially equal distances from the respective side walls (see e.g. figure 2 of Hotea).

Per claim 14, Hotea discloses a front end defining an engaging portion for engaging a mating terminal, the insulation displacement-terminal portions being rearward of the engaging portion, the locks being rearward of the insulation-displacement portions (see figure 2).

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new grounds of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ross Gushi whose telephone number is (571) 272-2005. If attempts to reach the examiner by phone are unsuccessful, the examiner's supervisor, Renee Luebke, can be reached at 571-272-2009. The phone number for the Group's facsimile is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Ross N. Gushi/

Primary Examiner, Art Unit 2833